

REMARKS

Claims 1-5 are pending in the application and stand rejected.

Rejection under 35 U.S.C. §103

Claims 1-8 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Nanyjo (US 5,050,024) in view of Kikuri (US 6,473,273). Applicant respectfully traverses this rejection. The Examiner recites the elements of independent claim 1 and states that such elements are obvious over the primary reference to Nanyjo. The Examiner further states that the primary reference to Nanyjo:

[F]ails to disclose or fairly suggest comprising boards for having the corresponding magnetic heads fixed thereto, wherein the magnetic heads are arranged so as to have the same height from the corresponding gaps to board surfaces of the corresponding boards and also to be symmetric (interpreted from applicant specification para. 0055) with respect to a rotating axis of the rotating cylinder. (Office Action, page 3).

Thus, according to the Examiner, the primary reference to Nanjo fails to teach or suggest certain elements of claim 1. The Examiner then cites the secondary reference to Kikuri as providing the missing elements. However, based on the pertinent dates of the Kikuri reference, applicant submits that the secondary reference should be removed from consideration for the following reasons:

The subject application was filed in the U.S. on June 20, 2003, based on a Japanese priority date of June 21, 2002. Applicant has met all of the requirements for claiming foreign priority under 35 USC §119(d), as indicated by box 12, 12(a), and 12(a)(1) of form PTOL-326 of the subject Office Action.

In that regard, Kikuri was filed in the U.S. on March 23, 2000, which is before the filing date of the subject application, but issued on October 29, 2002, which is after the priority date of

the subject application. Accordingly, Kikuri is prior art under §102(e). The front sheet of Kikuri indicates that it is assigned to Alps Electric Co., Ltd of Tokyo, Japan. However, the subject application is also assigned to Alps Electric Co., Ltd of Tokyo, Japan, as evidenced by the recordation at Reel 014224/Frame 0656 recorded on May 28, 2003.

Because the subject application and the Kikuri reference were commonly owned at the time of the invention, 35 USC §103(c) is applicable. Under 35 USC §103(c), prior art which would qualify under §102(e), if owned in common with the patent application, cannot be applied to support a rejection. Accordingly, applicant submits that the secondary reference to Kikuri should be removed from consideration.

Removal of the secondary reference to Kikuri leaves the primary reference to Nanyjo as the only reference under §103. As the Examiner indicated in the subject Office Action, Nanyjo “fails to disclose or fairly suggest” certain elements of claim 1. Because such elements are not taught or suggested in Nanyjo, applicant submits that independent claim 1 is not unpatentable over Nanyjo. For the reasons given above, applicant also submits that dependent claims 2-5 are not unpatentable over Nanyjo as Nanyjo fails to disclose or suggest certain claimed elements.

Conclusion

In view of the above remarks, applicant respectfully submits that the claims are in condition for allowance. Should the examiner deem a telephone conference to be of assistance in advancing the application to allowance, the examiner is invited to call the undersigned attorney at the telephone number below.

Respectfully submitted,

A handwritten signature in dark ink, appearing to read 'E D Cohen', is written over a horizontal line.

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